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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,637	02/16/2005	Boris Mayer	30691/DP023	1456
4743 7590 07/16/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER VERDI, KIMBLEANN C	
			ART UNIT 2194	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/524,637

**Applicant(s)**

MAYER ET AL.

**Examiner**

KimbleAnn Verdi

**Art Unit**

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2008 and 16 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB008)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 10-12 are pending in the current application.

#### ***Claim Objections***

1. Claims 10-12 are objected to because of the following informalities:
  - a. Claim 10, lines 15 and 16, the recitation of "creating jobs", should be "creating notification jobs";
  - b. Claim 12, lines 13 and 14, the recitation of "notification requests", should be "notification job requests";
  - c. Claim 12, line 13, the recitation of "a storage module", should be "the storage module";
  - d. Claim 12, line 6, the recitation of "for the transmission" should be "for transmission".
  - e. Appropriate correction is required.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 10/524063.

Although the conflicting claims are not identical, they are not patentably distinct from each other. The examiner can ascertain no difference between the claims of the present application and that of copending Application No. 10/524063. It is noted that the minor

difference encompass replacement of the recitation of the limitations in the claims and it appears to be substantially the same or duplicate or in some instance obvious over one another. For example, claim 1, functions performed by the steps are the same and obvious as the steps of claim 18 of copending Application No. 10/524063. This is a provisional obviousness-type double patenting because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 10 recites the limitation "of the requests" in line 11. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the examiner interprets "of the requests" as "requests".
7. Claim 10, line 8, and claim 12, line 8, it is not clearly understood how a communication interface transmits the notification information to a receiving device and if the receiving device is external to the device/system. What is a receiving device, how does the communication interface transmits the notification information to a receiving

device, is the receiving device part of the system or external to the device/system? (i.e. what is the relationship/connection between the receiving device and the communication interface, where is the receiving device located).

8. Claim 10, line 15, it is not clearly understood if the information for creating notification jobs depends on events within the electronic parcel compartment system. How does the information for creating notification jobs depends on events within the electronic parcel compartment system? (i.e. what is the relationship between the information for creating notification jobs and the events within the electronic parcel compartment system).

9. Claim 10 lines 19-20, it is not clearly understood which processing steps are the defined, definable or variable processing steps by the notification component triggered by the events. What processing steps are triggered by the events, and how are they triggered? (i.e. what are defined, definable, or variable processing steps).

10. Claim 12, line 6, it is not clearly understood how a communication interface transmits the notification information to a receiving device. What is a receiving device and how does the communication interface transmits the notification information to a receiving device? (i.e. what is the relationship/connection between the receiving device and the communication interface, where is the receiving device located).

11. Claim 12, lines 2-3, it is not clearly understood which system is having at least one database. Does the electronic parcel compartment system or postal shipping system have at least one database?

12. Claim 12, lines 14-15, it is not clearly understood if the notification requests are based on an event in the electronic parcel compartment system. How are the notification requests based on an event in the electronic parcel compartment system? (i.e. what is the relationship between the notification requests and an event within the electronic parcel compartment system, are all the notification requests based on one event).

***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 12 recites a "A device for transmission of notifications to users of an electronic parcel compartment system" however, it appears that a device for transmission of notifications to users of an electronic parcel compartment system would reasonably be interpreted by one of ordinary skill in the art as software, per se since the body of the claim appears to be software. Applicant claims a database, a central

Art Unit: 2195

sending component, communication interface, an external interface, and a storage module, as described by Applicant's specification, appear to be data structures which are functional descriptive material. However, function descriptive material is nonstatutory when claimed as descriptive material per se. Applicant describes the functionality of a database, a central sending component, communication interface, an external interface, and a storage module but does not disclose any hardware structure. As such, it is believed that a device for transmission of notifications to users of an electronic parcel compartment system of claim 12 is reasonably interpreted as functional descriptive material, per se and non statutory.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba (U.S. Patent 6,539,360 B1) in view of Reed et al. (hereinafter Reed) (U.S. Publication No. 2002/0095454 A1), and further in view of Weiser (WO 02/29731 A1).



18. As to claim 10, Kadaba teaches the invention substantially as claimed including a method for the transmission of notifications by a notification component to users of an electronic parcel compartment system within a postal shipping system, comprising:

transmitting (e.g. uploading) data from at least one database (data stored on Hard Drive 34, Fig. 2) to a central sending component (e.g. step 104, Fig. 3, the pre-alert files are uploaded via the intranet interface 48, Fig. 2, to the Intranet Web Site 54, Fig. 2),

converting (e.g. generating) the data in the central sending component into notification information (e.g. an alert) (an alert is generated at step 119, Fig. 3, to initiate a problem solving effort by the Exception Center 11, Fig. 1, the alert may be sent to appropriate carrier personnel by signal to the fault alert pager 74, Fig. 2, col. 9, lines 29-32), and

transmitting (e.g. signaling) the notification information to a communication interface (Pager Interface 70, Fig. 2, connects the Central Computer System 15, Fig. 2, to Pagers 72, Fig. 2, carried by customers (consignors or consignees) col. 6, lines 54-56) and from the communication interface to at least one receiving device (e.g. Customer Pager 72, Fig. 2, step 116, Fig. 3, the carrier can notify the customer directly by e-mail, or by signal to the Customer Pager 72, Fig. 2, col. 9, lines 16-18),

storing notification jobs (e.g. "pre-alert files") in a storage module (e.g. Internet Web Site, 65, Fig. 2) (step 107, Fig. 3, the pre-alert files are updated as the packages are scanned whenever they are handled at a consolidation point, the arrival, presence, and departure of the package, as well as any noted exceptions, are posted to the

Internet Web Site 65, Fig. 2, col. 8, lines 6-10) and transmitting at least some of the requests for the transmission of notifications (e.g. updates pre-alert files) by a control circuit (e.g. Central Computer 15, Fig. 2) to the storage module (e.g. Internet Web Site, 65, Fig. 2) (Central Computer 15, Fig. 2, updates the pre-alert files on the Intranet Web Site 54, Fig. 2, with information downloaded from the Internet Site 65, Fig. 2, col. 8, lines 15-17), and

acquiring (e.g. consolidating and sorting) the notification jobs contained in the storage module (e.g. PLD data) by a reading module (step 103, Fig. 3, the PLD data received from each consignor is consolidated and sorted into region-specific files, each of which is sorted by district and destination postal code, these files are referred to herein as "pre-alert files", col. 7, lines 33-37) and transmitting the notification jobs to the central sending component (step 104, Fig. 3, the pre-alert files are uploaded via the Intranet Interface 48, Fig. 2, to the Intranet Web Site 54, Fig. 2, col. 7, lines 38-39),

transmitting (e.g. emailing) the information for creating jobs (e.g. PLD Information for creating "pre-alert files", col. 7, line is transmitted to the control circuit (e.g. Computer 15, Fig. 2) via an external interface (e.g. step 101, Fig. 3, the Computer 15, Fig. 2, receives PLD information via e-mail from the Consignor Computer 17, Fig. 2, for packages being shipped on that day, col. 7, lines 25-27),

whereby the information (e.g. PLD Information and "pre-alert files") depends on events (e.g. shipping or package status updates) within the electronic parcel compartment system (PLD Data (e.g. package status) includes the source address or postal code for the package, a reference or tracking number, the final destination

Art Unit: 2195

address and postal code, the package weight, the level of service and rate applied to the package, the value of the contents, customer codes or description of the contents, hazardous material identification, special handling requirements, and other pertinent information related to the package, any of these items of information can be transmitted to or made available to personnel at downstream consolidation points, to the consignor, and to the consignee, col. 7, lines 5-15, the pre-alert files are updated as the packages are scanned whenever they are handled at a consolidation point, the arrival, presence, and departure of the package, as well as any noted exceptions (e.g. shipping status), are posted to the Internet Web Site 65, Fig. 2, col. 8, lines 6-10), and

the events (e.g. package status updates on package scan) triggering defined, definable or variable processing steps (e.g. update to pre-alert files) by the notification component (step 107, Fig. 3, the pre-alert files are updated as the packages are scanned whenever they are handled at a consolidation point, the arrival, presence, and departure of the package, as well as any noted exceptions, are posted to the Internet Web Site 65, Fig. 2, col. 8, lines 6-10).

19. Kadaba does not explicitly disclose categorizing the events in classes and transmitting the notifications to at least one user for whom the event is defined to be pertinent.

20. However Reed teaches categorizing the events in classes (Event 116 class, Fig. 3, is an abstract class defining the attributes for Scheduled Events 117, Fig. 3 and logged events 118, Fig. 3, paragraph [0140]).

21. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the PLD Data of Kadaba with the teachings of Events from Reed because this feature would have provided a mechanism to track System events for purposes of accumulated statistics, tracking user or communications object activity, documenting errors, providing payment transaction receipts (paragraph [0140] of Reed), and coordination of package deliveries over a physical communications network such as a postal network (paragraph [0531] of Reed).

22. In addition Weiser teaches transmitting the notifications as SMS to at least one user for whom the event is defined to be pertinent (steps 5-7, Figure 1, page 6, lines 1-31).

23. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified PLD Data of Kadaba as modified by Reed with the teachings of notification server from Weiser because this feature would have provided a mechanism for mailbox owner with an electronic, easily accessible, secure, and rapid notification when mail/parcels have been distributed into their real and/or virtual mailboxes (page 3, lines 7-10 of Weiser).

24. As to claim 11, Kabada teaches using at least one template (e.g. pre-defined standards, col. 9, line 28), the central sending component converting (e.g. generating) the data transmitted from the database into the notification information (BI) (e.g. an alert) (an alert is generated at step 119, Fig. 3, to initiate a problem solving effort by the Exception Center 11, Fig. 1, the alert may be sent to appropriate carrier personnel by signal to the fault alert pager 74, Fig. 2, col. 9, lines 29-32).

25. As to claim 12, this claim is rejected for the same reason as claim 10, see the rejection to claim 10 above.

### ***Response to Arguments***

26. Applicant's arguments with respect to claims 10 -12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KimbleAnn Verdi whose telephone number is (571)270-1654. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST..

Art Unit: 2195

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Meng-Ai An/  
Supervisory Patent Examiner, Art Unit 2195  
June 25, 2008  
KV